

REMARKS

Favorable reconsideration of this application, in light of the preceding amendments and following remarks, is respectfully requested.

Claims 1, 2, 4-6, 14-16, 19-20, 28-30, 32-34, 42, 57, 58, 60-62 and 70-78 are pending in this application. Claim 18 is cancelled. Claim 19 is amended.

Double Patenting

Claims 1, 2, 4, 5, 6, 29, 30, 32, 33, 34, 42, 57, 58, 60, 61, 62, and 70 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 71-88 respectively of copending Application No. 12/222,445. The Applicant notes that the Examiner listed claim "1" in-between claims 6 and 29 in the listing of the claims provisionally rejected. As claim 1 was already listed at the beginning of the claim listing, the second listing for "1" appears to be a typographical error. The Applicant respectfully requests the Examiner to provide clarification of what the claim number between claims 6 and 29 should read.

The Applicant respectfully notes that these rejections are provisional rejections and defers from responding to them at this time. The scope of the claims contained in copending application no. 12/222,445 may change potentially rendering these double patenting rejections moot. The Applicant will defer from responding to these rejections until such time as the claims of copending application no. 12/222,445 are allowed.

Claims 1, 15, 29, and 57 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 19, 24, 28 and 9 respectively of copending Application No. 10/762,538. The Applicant notes that the listing of claim 9 is out of sequence and appears to be a typographical

error. The Applicant requests that the Examiner provide clarification of which claim "9" is referring to.

The Applicant respectfully notes that these rejections are provisional rejections and defers from responding to them at this time. The scope of the claims contained in copending application no. 10/762,538 may change potentially rendering these double patenting rejections moot. The Applicant will defer from responding to these rejections until such time as the claims of copending application no. 10/762,538 are allowed.

Claims 1, 29, and 57 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2, 9, and 17 respectively of copending Application No. 11/898,040.

The Applicant respectfully notes that these rejections are provisional rejections and defers from responding to them at this time. The scope of the claims contained in copending application no. 11/898,040 may change potentially rendering these double patenting rejections moot. The Applicant will defer from responding to these rejections until such time as the claims of copending application no. 11/898,040 are allowed.

Claim Rejections under 35 U.S.C. § 103

Claims 1, 2, 15, 16, 29, 30, 57, 58, and 71-78 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication 2003/0007432 to Minamino et al. ("Minamino") in view of U.S. Patent 5,892,797 to Deng ("Deng"). The Applicant respectfully traverses this rejection.

According to the new Examination Guidelines for Determining Obviousness under 35 U.S.C. § 103 in view of the Supreme Court decision of *KSR International, Co. v. Teleflex, Inc.* it is stated that the proper analysis for a determination of obviousness is whether the claimed invention would have been obvious to one of ordinary skill in

the art after consideration of all the facts. The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reasons why the claimed invention would have been obvious. An Office Action must explain why the differences between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. See 72 Fed. Reg. 57526, 57528-529 (Oct. 10, 2007).

The Applicant respectfully asserts that neither Minamino nor Deng, either separately or in combination, teach, suggest, or otherwise render obvious all of the limitations set forth in the claims, nor has there been a clear articulation made of why the differences between the prior art and the claims would have been obvious to one of ordinary skill in the art.

Independent claim 1 recites a computer readable recording medium including among other things “control information required for recording or reproduction of the main data and a bi-phase modulation data required for reproducing the control information or the main data, said control information being encoded as wobble pits.” Further, claim 1 describes that the bi-phase modulation data “is recorded along with a wobble pattern of the wobbled pits.” The Applicant notes that the control information is required for recording or reproducing the main data and the bi-phase modulation data is required for reproducing the control information or the main data. Thus, the claim recites two types of information control information and bi-phase modulation data.

In paragraphs [0395] – [0404] and FIG. 36 of Minamino, the position information and the control information described in Minamino are formed by combining wobbles in each subdivided information unit of the wobble groove in the lead-in area. Therefore, it can be reasonably concluded that the control information described in Minamino corresponds to the bi-phase modulation data described in

claim 1. However, as described above, claim 1 recites both control information and bi-phase modulation data. If the bi-phase modulation data of claim 1 corresponds to the control information of Minamino then Minamino does not disclose the control information described in claim 1. (If the Examiner were to allege that the control information of Minamino corresponded to the control information of claim 1 then there would be no teaching of information that corresponded to the bi-phase modulation data recited in claim 1.)

The position information alone described in Minamino could not be said to correspond to either the control information or the bi-phase modulation data of Minamino because the position information of Minamino does not have the features recited in claim 1 that correspond to the control information or bi-phase modulation data.

The Applicant notes that Deng does not overcome and has not been alleged to overcome the insufficiencies described above of Minamino. Rather, on page 5, Deng discloses a Manchester encoding scheme wherein each bit is determined by a transition of the signal from high to low or low to high in the middle of a predetermined period. Therefore neither reference, whether taken individually or in combination teach suggest or otherwise render obvious all of the features set forth in independent claim 1. Therefore, a *prima facie* case of obviousness for independent claim 1 has not been made.

The Applicant respectfully requests that the rejections under 35 U.S.C. 103(a) of independent claim 1 and its corresponding dependent claims be removed.

The Applicant notes that language similar to that discussed above with respect to independent claim 1 can also be found in the other independent claims, claims 15, 29, and 57. Therefore the Applicant respectfully asserts that the combination of

Minamino and Deng whether considered separately or in combination does not teach suggest or otherwise render obvious all of the features of these claims for at least the same reasons set forth above with respect to independent claim 1. Therefore, the Applicant respectfully requests that the rejections under 35 U.S.C. 103(a) of independent claims 15, 29, and 57 and their corresponding dependent claims be removed.

Claims 4-6, 20, 32-34, and 60-62 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Minamino in view of Deng in view of Alleged Applicant Admitted Prior Art ("AAAPA"). Claims 14, 28, 42, and 70 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Minamino in view of Deng in view of U.S. Patent Publication 2002/0089920 to Gotoh et al. ("Gotoh"). Claims 18 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Minamino in view of Deng in view of Gotoh and even further in view of AAAPA. The Applicant respectfully traverses these rejections.

The Applicant notes that claims 4-6, 20, 32-34, 60-62, 14, 28, 42, 70, 18, and 19 are dependent upon one of the independent claims discussed above. The independent claims discussed above are patentable over Minamino in view of Deng for the reasons set forth above. Further, the AAAPA and Gotoh, whether taken separately or in combination, have not been alleged to cure the insufficiencies described above with respect to Minamino. Therefore, claims 4-6, 20, 32-34, 60-62, 14, 28, 42, 70, 18, and 19 are patentable at least by reason of their dependency upon one of independent claims 1, 15, 29, or 57. Therefore, the Applicant respectfully requests that the rejections under 35 U.S.C. 103(a) of claims 4-6, 20, 32-34, 60-62, 14, 28, 42, 70, 18, and 19 be removed.

CONCLUSION

Accordingly, in view of the above amendments and remarks, reconsideration of the objections and rejections and allowance of each of the pending claims of this application is earnestly solicited.

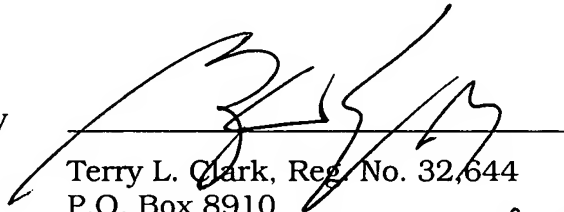
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Terry L. Clark at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNES, DICKEY, & PIERCE, P.L.C.

By



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